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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Jean DE RIGAL et al.

Group Art Unit: 1612

Application No.: 10/743,455

Examiner: B. PACKARD

Filed: December 23, 2003

Docket No.: 118111

For: COSMETIC COMPOSITIONS AND CONTRAST CARDS FOR CHARACTERIZING
THEM

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the
Examiner's Answer dated March 30, 2009.

I. ARGUMENT

The Examiner's Answer fails to rebut any of the arguments set forth in the November 6, 2008, Appeal Brief, and fails even to address many of them. Thus, all arguments presented in the Appeal Brief still apply, and the Examiner apparently concedes the validity of all the Appellants' arguments that were not addressed in the Examiner's Answer.

Specifically, the Examiner's Answer fails to rebut Appellants' arguments that (1) the combined teachings of Bourjois and MacFarlane fail to disclose or establish a reason to provide every limitation any of the claims; (2) combining the teachings of Bourjois and MacFarlane is improper; and (3) the Examiner fails to establish a *prima facie* case of obviousness of the claims and has improperly shifted the initial burden of proving non-obviousness to Appellants.

Instead, the Examiner's Answer continues to read into the applied references far more than they disclose, and unreasonably modifies the applied references without the requisite articulated reasoning and rational underpinning to support a conclusion of obviousness. As such, the Examiner's Answer fails to remedy the deficiencies of the record or establish that the applied references, alone or in combination, disclose or would have established any reason or rationale to provide each and every limitation recited in the rejected claims, much less the combination of features recited in the claims. In addition, the Examiner's Answer fails to rebut that it is improper to combine the teachings of Bourjois and MacFarlane. Thus, Examiner fails to establish a *prima facie* case of obviousness and has improperly shifted the initial burden of proving non-obviousness to Appellants. Therefore, for at least these reasons, the obviousness rejection is improper.

Accordingly, this Honorable Board should reverse the rejection of claims 1-15 and 34-38.

**A. The new arguments in the Examiner's Answer fail to
rebut any of the arguments set forth in the Appeal Brief**

1. Examiner's Summary of Appellants' Arguments

The new arguments on page 5 of the Examiner's Answer mischaracterize the claims and Appellants' arguments as set forth in the Appeal Brief. For example, the Examiner notes, "claim 1 is directed to foundation cosmetic compositions, which comprises a physiologically acceptable medium, at least one coloring agent having a yellow or orange coloration, and having a significant reflectance in the range from 550 to 675 nm and reflective particles. The rest of the claim 1 appears to be directed to functional language which provides various properties of the foundation cosmetic composition when applied to a contrast card." The Examiner's Answer also asserts that the "claims are directed to a composition (claims 1-2), where the only components recited appear to be the presence of a physiological/cosmetic acceptable medium, yellow or orange coloration, and reflective particles." See Examiner's Answer, page 6.

However, this new characterization incorrectly treats the reflectance property of the foundation cosmetic composition of claim 1 as being tied to the presence of a contact card and ignores Appellant's statement on page 8 of the Appeal Brief, that "the composition according to claim 1 has a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm" (emphasis added). Claim 2 recites a similar feature. See Appeal Brief, page 9. Such a feature, which represents more than mere orange coloration, is directed to a reflectance property of the foundation cosmetic composition, regardless of whether it is applied to a contrast card.

Thus, Examiner's new characterization of the features of the claims erroneously construes the independent claims and also fails to provide any suggestion that this feature is disclosed in or obvious from the applied references. Accordingly, the Examiner's Answer

does not even suggest, much less establish, that the combined teachings of Bourjois and MacFarlane disclose or establish a reason to provide every limitation of any of the claims, much less the combination of such features. For at least this reason, the obviousness rejection of the claims is improper and should be reversed.

2. Examiner's Response to Appellants' Arguments

In regard to the assertions in the first three paragraphs of the Response to Arguments section (§10), the Examiner's Answer substantially repeats portions of the argument contained in the January 23, 2008, Final Rejection. Therefore, in addition to the arguments presented herein, Appellants rely on the arguments presented in the November 6, 2008, Appeal Brief.

In addition, Appellants respectfully submit that the Examiner has mischaracterized *In re Greenfield*, 571 F.2d 1185 (CCPA 1978). See Examiner's Answer, page 5 lines 5-7. Specifically, there is no requirement for Appellant to provide factual verification of a property recited in a claim. Instead, in *In re Greenfield*, the Court found that in order to rebut the *prima facie* case of obviousness, a prior art property that had been relied upon by the applicant had to be verified. Accordingly, Appellants respectfully submit that they are not required to provide factual verification of the properties recited in the present claims.

The Examiner's Answer also presents the following new arguments:

1. "MacFarlane was cited to disclose the use of yellow and orange colors in cosmetic compositions, which have reflective properties." See Examiner's Answer, page 6.
2. "Bourjois teaches it would have been obvious to vary colorants to 'lighten' a darker area of the face, thus providing motivation to vary the colorant ranges depending on the part of the face to lighten." *Id.*
3. "Where variation is suggested in the prior art, it would have been obvious to one of ordinary skill to adjust the same for various applications, making the instantly claimed [sic] obvious as the skilled artisan modifies the foundation for various facial colors." *Id.*
4. "As such, a *prima facie* showing has been made to select varying degrees of colorant which would read on the instantly claimed ranges and the method of use

would be obvious to one of ordinary skill given the purpose of the cosmetic compositions." *Id.*

First, these new arguments fail to address Appellants' argument that it is improper to combine the teachings of Bourjois and MacFarlane in the first place. For example, the Examiner fails to rebut Appellant's argument regarding a lack of reason or rationale for one of ordinary skill in the art practicing MacFarlane's empirical color assessment methods to have turned to the teachings of Bourjois, which describes a subjective color assessment method. See Appeal Brief, pages 20-22. Thus, for at least the reason that it is improper to combine the teachings of Bourjois and MacFarlane, the applied references would not have rendered obvious independent claims 1 and 2 or any of the claims dependent therefrom.

In addition, the improperly combined teachings of Bourjois and MacFarlane still fail to disclose or establish any reason to provide a foundation cosmetic composition comprising the claimed combinations of components and properties of independent claims 1 and 2. The requisite articulated reasoning and rational underpinning to support the current obviousness rejection of the claims is not present in the above new arguments; and as asserted by the Appellants on pages 13-16 of the Appeal Brief, the Examiner fails to establish that the applied references disclose or establish any reason or rationale to provide each and every feature, much less the combination of features, recited in claims 1 and 2.

As indicated above, the Examiner's Answer asserts that the only components in claims 1 and 2 are the presence of a physiological/cosmetic acceptable medium, yellow and orange coloration, and reflective particles. See Examiner's Answer, page 6. The Examiner's Answer further asserts that MacFarlane was cited to disclose the use of yellow and orange colors in cosmetic compositions, which have reflective properties, and that Bourjois teaches it would have been obvious to vary colorants to lighten a darker area of the face. See Examiner's Answer, page 6 (emphasis added). This characterization of the claimed features ignores,

among other things, a "composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm," as required by claims 1 and 2. Furthermore, the record articulates no reasoning for varying the reflectance of the composition or that variation of the colorants relates to the reflectance of the composition. Accordingly, the Examiner must be asserting that the reason or rationale for providing a composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm is present in MacFarlane.

However, MacFarlane does not disclose a composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm, as required by claim 1 and 2, nor does it provide any reason or rationale to provide such a feature. There is no suggestion from the applied references or the record that all of the prior art has the claimed properties or even that any of the prior art possesses the claimed properties. Thus, the combination of Bourjois with MacFarlane fails to render obvious each and every feature of claim 1. As argued on page 17 of the Appeal Brief, MacFarlane is directed to a method and instrument for identifying categories of skin coloration for compatibility with colors of clothing, makeup, etc. Clearly, this provides no guidance for one of ordinary skill in the art at the time of the invention to achieve a composition having a reflectance ranging from 10 to 45 % in the range from 600 to 680 nm, much less the combination of features recited in claims 1 and 2.

Furthermore, Appellants respectfully submit that to adjust or optimize a parameter it must first be recognized as a result-effective variable. See MPEP 2144.05(II)(B). Clearly the above record fails to establish that the reflectance of the composition or any of the other recited properties, much less their combination, is a result effective variable. As stated in MPEP 2144.05(II)(B), "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation," citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Because

the record does not establish and the applied references do not teach or suggest the reflectance and other recited properties of the composition as result-effective variables, it would not have been obvious to one of ordinary skill in the art from these references to adjust (or optimize) the teachings of the applied references to arrive at the combination of features recited in claims 1 and 2.

In fact, as argued on pages 13-16 of the Appeal Brief, the applied references fail to disclose any compositions meeting any of the limitations of claims 1 and 2, much less the combination of features recited in any of claims 1-15 and 34-48, which were independently argued in the Appeal Brief.

To address these claims it appears that the Examiner argues that "where variation is suggested in the prior art, it would have been obvious to one of ordinary skill to adjust the same for various applications, making the instantly claimed [sic] obvious as the skilled artisan modifies the foundation for various facial colors. As such, a *prima facie* showing has been made to select varying degrees of colorant which would read on the instantly claimed ranges and the method of use would be obvious to one of ordinary skill given the purpose of the cosmetic compositions." See Examiner's Answer, page 6. This is the only support that the Examiner provides to support the obviousness rejection of each of the independently argued claims.

Such a conclusion without a rational basis is not enough to support a rejection on obviousness grounds. This standard is simply not met by the mere conclusory statements provided in the Examiner's Answer; such as the Examiner's conclusion that it would have been obvious to modify Bourjois in view of MacFarlane because a skilled artisan would recognize that such modification would be considered a mere choice of a preferred material suitable given the purpose of the cosmetic compositions. If this represented the current state of the law, no patents directed to cosmetic compositions could be granted.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, the desirability of the combination has not been established by the prior art or the record and, thus the combination of Bourjois and MacFarlane is improper.

In addition, the above new arguments and those already on the record fail to address how the improperly combined teachings of Bourjois and MacFarlane disclose or establish any reason to provide a composition of claim 1 or 2 that is liquid at room temperature, as recited by claims 8 and 9, respectively. Neither reference provides any suggestion of its teachings being applicable to liquid cosmetics. Thus, for at least these reasons, the applied references would not have rendered obvious claims 8 and 9.

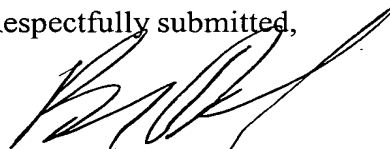
Accordingly, for at least these reasons, Appellants respectfully submit that the Examiner's Answer continues to read into the applied references far more than they disclose, and unreasonably modifies the applied references without the requisite articulated reasoning and rational underpinning to support a conclusion of obviousness. Thus, Appellants' non-rebutted and/or non-addressed arguments that: (1) the combined teachings of Bourjois and MacFarlane fail to disclose or establish a reason to provide every limitation of any of the claims; (2) combining the teachings of Bourjois and MacFarlane is improper; and (3) the Examiner fails to establish a *prima facie* case of obviousness of the claims and has improperly shifted the initial burden of proving non-obviousness to Appellants, make clear that the rejections should be reversed.

Accordingly, reversal of the obviousness rejections of claims 1-15 and 34-38 is respectfully requested.

II. CONCLUSION

For all of the reasons presented in Appellants' Appeal Brief and above, Appellants respectfully request this Honorable Board to reverse the rejection of claims 1-15 and 34-38.

Respectfully submitted,



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